

REMARKS

Claims 1-11 and 13-37 are all the claims pending in the application.

I. Withdrawn Rejections

Applicants note with appreciation that the rejection of claims 1, 2 and 4-14 under 35 U.S.C. § 102(e) over Aoai et al., and the rejection of claim 3 under 35 U.S.C. § 103(a) over Aoai et al. have been withdrawn.

II. Response to Rejections Under 35 U.S.C. § 102 and 103

In paragraph No. 2 of the Office Action, claims 1, 2, 4-14, 24, 25, 27, 28 and 30 are rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Allen et al (U.S. Patent No. 6,610,456). Further, in Paragraph No. 3 of the Action, claims 15 and 16 are rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Allen et al.

Applicants respectfully traverse the rejections for at least the following reasons.

Allen et al teaches that the composition may contain an ionic or non-ionic surfactant (col. 16, lines 51-53). As the Examiner concedes, Allen et al does not specify the surfactant to be a fluorine- or silicon- containing surfactant.

Applicants respectfully submit that an ionic or non-ionic surfactant is a generic term which includes a vast number of surfactants, and that a fluorine- or silicon- containing surfactant is only one species in the genus of ionic and non-ionic surfactants. Accordingly, one of ordinary skill in the art would not be able to at once envisage a fluorine- or silicon- containing surfactant in view of the disclosure of Allen et al. For this reason, Allen et al does not disclose or anticipate the present invention.

Further, as noted above, a fluorine- or silicon-containing surfactant is only one species among a vast number of surfactants. As described at page 71 of the specification of the present application, last full paragraph, in the present invention, a fluorine- or silicon-containing surfactant is specifically effective in suppressing development defects and improving coating properties when used with a resin containing the structure of the formula (I).

In this regard, Applicants submit herewith a Declaration under 37 C.F.R. § 1.132 executed by Mr. Kazuyoshi Mizutani, a co-inventor of the present invention. The experimental data in the Declaration together with those in the specification of the present application clearly demonstrate the criticality of a fluorine- or silicon-containing surfactant and thus establish the patentability of the present invention.

Specifically, in the Declaration, positive photoresist compositions were prepared in the same manner as described in Example 1 of the specification of the present application, except for using Polymers A, B and C, which correspond to those prepared in Examples 6, 9 and 10 of Allen et al, respectively, each containing no surfactant or a surfactant W-1 to W-4 as described in Table 5 of the specification of the present application. These positive photoresist compositions are shown in Table A of Mr. Mizutani's Declaration.

The positive photoresist compositions were evaluated in terms of development defects and coating properties in the same manner as described in Example 2 of the specification of the present application. The results are summarized in Table A of the Declaration.

As seen from the data in Table A, only the positive photoresist compositions containing a fluorine- or silicon-containing surfactant (W-1 to W-3) provided a low occurrence of

development defects and excellent coating uniformity, as compared to the positive photoresist compositions containing a non fluorine- or silicon-containing surfactant (W-4) or no surfactant.

In view of the foregoing reasons, Applicants respectfully submit that the present claims are not anticipated or rendered obvious in view of Allen et al and that the rejections should be withdrawn.

III. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.


Respectfully submitted,

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

23373

CUSTOMER NUMBER


Fang Liu
Registration No. 51,283

Date: February 2, 2005